

REMARKS

In the Office action, the Examiner rejected claims 1–18 and 24–41 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,737,365 to Smith in view of U.S. Patent No. 5,286,545 to Simmons, Jr. Applicants traverse the rejections. In view of the amendments above, and the remarks below, Applicants respectfully request reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

Applicants have studied the cited references in view of the pending claims and the reasons expressed in the Office action. Applicants respectfully disagree that claims 1–18 and 24–41 are rendered obvious by the cited references, alone or in combination; however, Applicants presently amend independent claims 1, 11, 24, and 35 and dependent claim 32 to more clearly define that which they believe to be their invention. Accordingly, Applicants request reconsideration of the rejections for at least the reasons discussed below. Applicants also presently amend several of the dependent claims to conform to the terminology of the amended independent claims as well as to correct a few minor typographical errors.

Claims 1, 11, 24, and 35

Applicants presently amend independent claims 1, 11, 24, and 35 to be directed to “method[s] of inlaying a design into a laminate sheet and bonding the inlaid laminate to a *foam core of a sports board*.” Each claimed method includes some variation on steps of placing a flexible laminate sheet with a congruent insert over a foam core of a sports board and laminating them thereto. Neither Smith nor Simmons, Jr. disclose or suggest bonding, or laminating, an inlaid laminate to a “foam core of a sports board.”

Smith is directed to a method of making composite inlaid design products, and specifically identifies “table top[s], dresser top[s], drawer front[s], [and] wall panel[s]” as examples of appropriate supporting base structures for the inlaid designs described. [Col. 3, lines 33–42] Simmons, Jr. also fails to teach or suggest application of an inlaid laminate sheet to a foam core of a sports board. Rather, Simmons, Jr. is directed to a laminated wood product.

Additionally, as presently amended, independent claims 1, 11, 24, and 35, recite “flexible laminate sheet[s].” As noted in the present application, a non-exclusive example of a suitable flexible laminate sheet may be constructed of “polyethylene foam, in the range of about 1/16” to 1/4” thick, and with a density in the range of about 4–8 lbs/ft³.” [p. 4, lines 14–15] Other materials may also be used including, but not limited to, polystyrene, polypropylene, and polyvinylchloride, all of which—when appropriately configured for application to a foam core of a sports board—are flexible. Smith, on the other hand, is directed to *wooden* inlay designs that are simply not suitable for lamination to foam cores of sports boards, which typically include contoured surfaces.

Accordingly, for at least the above reasons, the proposed combination fails to teach or suggest each and every element of independent claims 1, 11, 24, and 35, and therefore cannot render them obvious.

Claims 24 and 35

Independent claims 24 and 35 both include some variation on cutting an inlay design from a first flexible laminate sheet, cutting congruent inserts from second and third flexible laminate sheets, and placing the inserts into the inlay aperture of the first flexible laminate sheet. That is, both claims 24 and 35 require the use of *three* separate

flexible laminate sheets. Neither Smith nor Simmons, Jr. teaches or suggests cutting congruent inserts from two separate flexible laminate sheets to be placed in a separate flexible laminate sheet having an inlay aperture therein.

The Office action cites column 3, line 60 through column 4, line 8 of Smith for disclosing "cutting a congruent insert having at least two parts from a third laminate sheet leaving an inlay aperture, wherein at least one of the part is placed in the inlay aperture of the first laminate sheet." [OA p. 7, see *also* p. 10] Applicants have reviewed Smith, including the cited passage, and respectfully disagree. As best illustrated in Figs. 1–3, Smith only discloses the use of *two* materials (a light and dark wood in the illustrated example). Accordingly, for at least this additional reason, the proposed combination of Smith and Simmons, Jr. fails to teach each and every element of independent claims 24 and 35, and therefore cannot render them obvious.

Claims 8, 18, and 31

Claims 8, 18, and 31 are dependent on claims 1, 11, and 24, respectively, and recite that the "flexible laminate sheets are made from a polymer material selected from the group consisting of polyethylene, polystyrene, polypropylene, and polyvinylchloride." The Office action asserts that "the various polymeric sheet materials . . . are well known and conventional in the art. These polymers inherently have good compatibility with other materials as well as good color and texture characteristics. For these reasons, it would have been obvious to one having ordinary skill in the art . . . to employ such polymeric materials in the method of Smith in view of Simmons, Jr." [OA, pp. 3–4, 6, and 8–9]

Again, Applicants respectfully disagree with the Office action. As mentioned, Smith specifically identifies “table top[s], dresser top[s], drawer front[s], [and] wall panel[s]” as examples of appropriate supporting base structures for the inlaid designs described [Col. 3, lines 33–42], and describes wood as the preferred material. [Col. 2, lines 33–39] Neither Smith nor Simmons. Jr. teach or suggest using polymeric materials for the creation of intricate inlaid composite designs. Applicants submit that it would not have been obvious to one of ordinary skill in the art of furniture design—the art in which the primary reference, Smith, is within—and therefore it would not have been obvious to substitute the wood elements of Smith with the polymeric materials of claims 8, 18, and 31. Accordingly, Applicants challenge the Office action’s official notice of common knowledge and request that evidence be provided that would teach or suggest using the claimed polymeric materials in the process disclosed in Smith. For this additional reason, Applicants submit that the Office action fails to establish a prima facie case of obviousness of claims 8, 18, and 31.

Claim 32

Presently amended claim 32 depends from independent claim 24 and recites “placing the first flexible laminate sheet with the congruent inserts over the foam core so that the polymer sheet is between the first flexible laminate sheet and the foam core.” In other words, as described in the specification of the present application and in reference to Fig. 20, “top skin 310 is flipped over so that the side being bonded to sports board core 332, is the side of the top skin that includes the bonding material 350.” [p. 14, lines 5–6]

Smith, on the other hand, only discloses the use of a unitary sheet to hold the inlay design in place while the opposite side (i.e., the side opposite the unitary sheet) is "placed on a table surface . . . for lamination thereon in a conventional manner." [Col. 5, lines 52–54] In other words, the unitary sheet of Smith is used only to hold the inlay design in place while a separate process is used to actually adhere the inlay design to a table top or other surface. The method of claim 32, on the other hand, uses a polymer sheet to not only hold the inlay design in place, but also to provide the lamination material that adheres the inlay design to the foam core of the sports board. Accordingly, Smith fails to teach or suggest the elements of claim 32 and therefore the proposed combination of Smith and Simmons, Jr. fails to render it obvious.

Claim 33

Claim 33 depends from claim 32 and further defines the polymer sheet as a "polyethylene sheet." The Office action asserts that "various polymeric sheet materials, including polyethylene, are well known and conventional in the art. These polymers inherently have good compatibility with other materials as well as good color and texture characteristics. For these reasons, it would have been obvious to one having ordinary skill in the art . . . to employ such a polymeric sheet material in the method of Smith in view of Simmons, Jr." [OA, p. 9]

Applicants respectfully challenge the Office action's official notice of common knowledge and request that evidence be provided that would teach or suggest using the claimed polyethylene sheet in the process disclosed in Smith. As mentioned above, the unitary sheet used in Smith is *only* for the purposes of holding the inlay design in place while it is secured to a table top (or other surface), while the polyethylene sheet of claim

33 is used both for securing the congruent inserts *and* for laminating the flexible sheet to the foam core of a sports board. Accordingly, for at least this additional reason, the proposed combination fails to teach each and every element of amended claim 33.

Conclusion

Applicants believe that this application is now in condition for allowance in view of the above amendments and remarks. Accordingly, Applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on September 20, 2007.


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